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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/169,839	10/09/1998	DEBBY HINDUS	INT1P019	6129

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EXAMINER
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HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/169,839

Applicant(s)

HINDUS ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,19-27,29-36 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-17, 19-27, 29-36 and 38-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**EXAMINER'S RESPONSE**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 5-28-04 has been entered.

2. In response to applicant's amendment filed 5-28-04, all the amendments to the claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Claim Rejections - 35 USC § 102 & 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in

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section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 1, 3-6, 7-10, 22-27 and 29-33 rejected under 35 U.S.C. 102(x) as being anticipated by Pinter (US 5894506).

Pinter discloses a two way canned message system with a presence signal. Canned messages are communicated between two terminals such as shown in fig. 1. An example message is "I am working late" in col. 1 lines 45-46 that is an indication that the first person is at a first location (at work). The terminal is at this location and the terminal may communicate over physical lines (land lines) in col. 3 lines 30-33. The caller selects a canned message from a menu in col. 3 lines 55 of Richardson. Copies of the messages may be maintained at the terminals in col. 2 line 30. The transmitted signal includes at least a message code identifying the canned message and receiving terminal address in col. 3 lines 63-67. The pre-recorded message corresponding to the message code is played or displayed at the receiving terminal. Grouped message terminals are also included.

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6. Claims 1, 3-6, 7-10, 22-27 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter (US 5894506) in combination with LaPorta '122 (5970122).

Pinter is discussed above to include a canned messages such as "I am working late" that may indicate the present location. Pinter does not express describe the intended use of indicating location by the canned messages. LaPorta '122 discloses an analogous art canned message system with selection of location for canned messages in col. 13 lines 18-38. Examples of location in LaPorta '122 are home, office, and lab. This allows customization by the user. If message indicating current location is not clear in Pinter, the it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included canned message with location indication as disclosed in LaPorta '122 to allow specific commonly used entries to be customized by the user.

Regarding claim 3, 23-24, 26 and 29, LaPorta '122 discloses an analogous art two way paging system with group call message modification (abstract, col. 14) and any such features not clear in Pinter would have obvious to have included from LaPorta '122 to provide a more advanced set of transaction services.

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7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter (US 5894506) in combination with LaPorta '122 (5970122) as applied above and further in view of Ise (US 5257307).

Regarding claim 25, Pinter includes terminals in groups that could obviously include only two members. If matched pairs are not clear in Pinter, then the transmitter and receiver of Ise have memory cards with paired messages that form a matches pair as suggested by the terminal groups of Pinter.

8. Claims 19-21, 23-24 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter (US 5894506) in combination with LaPorta '122 (5970122) as applied above and further in view of Will (US 5479408).

Will discloses a two way paging system as claimed. In view of page 8 of applicant's specification, the acknowledgments, responses, original messages, location tracking, or any paging message corresponds to a presence signal. This allows highly reliable message delivery. See the abstract. Preprogrammed messages and responses can be defined by a user to be presented to another user as an original message or a response. A picture frame is included in figs. 6a-c, 8a-c and cols. 11-12. for quick and

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easy instillation. Col. 3 includes messages selecting from preprogrammed or composed by the user corresponding to modifying messages. See for example, Col. 5 lines 14-31, col. 16 lines 48-61, col. 19 lines 35-53, col. 16 line 20 - col. 28 line 36 and col. 36 line 61 - col. 37 line 35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the frame of claims 19-21 and 38-41 in view of the frame of Will in an analogous art system for quick and easy instillation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the message modification in view of the message composing in Will for highly reliable message delivery.

Will discloses transceiver in figs. 4A-4C which is considered to be a picture frame because it holds a photo ID 46. This frame includes a touch sensitive switch or key 48. A relay station is shown in figs. 6A-6C and 8A-8B to include a picture frame discussed on pages 11-12, and if it is not clear that the transceiver is a with key 48 is a frame then it would have been an obvious various in location of parts or obvious integration of parts to have

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combined transceiver with key 48 and the picture frame for user input. It further would have been obvious to have included this frame in the system of Richardson in order to identify the user or to blend into the environment.

9. Claims 11, 14-16 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter (US 5894506) in combination with LaPorta '122 (5970122) as applied above and further in view of Segal (US 5644627) and Poland (US 5401947).

Segal discloses an analogous art two way paging system with indication by audible or voice message, visual LED or LCD, or tactile signal (cols. 4-5). Tactile is vibratory or haptic motion. Poland discloses an analogous art selective indicator with heated (thermochromic) liquid crystal ink markings printed on a display. It would have been obvious to have included such indicators in the combination applied above to provide the user the convenience and flexibility of selecting from the various indicator modes and the heated LCD is suggested by Richardson indicating use of any well known visual display such as LCD in col. 7 and will showing LCD in col. 4A.

10. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter (US 5894506), LaPorta '122



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(5970122), Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of Easterling (US 5651049).

Easterling discloses an analogous art paging system with a receivers embedded in objects such as stuffed animals and it would have been obvious to have included such in the combination applied above in order to relate the receiver to the corresponding user or message recipient.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter (US 5894506) in combination with LaPorta '122 (5970122) in view of Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of McLaughlin (US 4975694).

McLaughlin discloses an analogous art paging receiver with a multiple color LED or lamp indicator and it would have been obvious to have included such in the combination applied above in order to provide multiple indications with a single lamp.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter (US 5894506), LaPorta '122 (5970122), Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of Park (US 5733131).

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Park discloses an analogous art paging receiver with a mechanical control such as movement of the mouth of a stuffed animal (fig. 2) and telephone input to the paging system (fig. 1). It would have been obvious to have included such in the combination applied above in order to provide inexpensive educational and/or entertainment device.

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter (US 5894506), LaPorta '122 (5970122) and Ise (US 5257307) as applied above in view of Shapira (US 5086394).

Shapira discloses an analogous art paging system with matched pairs and if matched pairs are not clear in Ise, then it would have been obvious to have included such match pairs in the combination applied above in order to provide introduction of users.

***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. Claim 33 is unclear because it depends from canceled claim 28. It is interpreted as depending on claim 27 for purposes of prior art rejections.

### ***Response to Arguments***

16. Applicant's arguments filed 5-28-04 have been fully considered but they are moot in view of the new grounds of rejection.

### ***CONTACT INFORMATION***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at [ebc@uspto.gov](mailto:ebc@uspto.gov). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (703) 305-4700 or TC 2600 Customer Service at (703) 306-0377.


Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Michael Horabik  
can be reached on (703) 305-4704.

EH  
8/9/04

  
EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
ART UNIT 2635